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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MYHRE, JAMES W	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/825,758	THOMPSON ET AL.	
	Examiner	Art Unit	
	James W Myhre	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 July 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-68* is/are pending in the application.

4a) Of the above claim(s) *49-68* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 December 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *04/03/01 & 05/28/0*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The Preliminary Amendment filed on July 16, 2001 inserting the priority claim has been entered. The currently pending claims are Claims 1-86.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-48, drawn to a method for delivering advertising content based on the elapsed time during a user session, classified in class 705, subclass 14.

II. Claims 49-86, drawn to a method of delivering advertising content each time a user requests an address (i.e. enters a URL request), classified in class 705, subclass 14.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I delivers the advertising content based on the elapsed time of a timer which is tracking the time between the

user interactions with the system. The subcombination has separate utility such as Group II can deliver an advertising content whenever the user requests a webpage (address) without the system timing the user interactions and basing the delivery of the advertising content on the elapsed time as in Group I.

4. During a telephone conversation with Amedeo Ferraro on August 31, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-48. Affirmation of this election must be made by applicant in replying to this Office action. Claims 49-86 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 6, 8-12, 16, 18, 19, 21, 42, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Landsman et al (6,314,451).

Claims 1 and 42: Landsman discloses a method for delivering advertising content to a user, comprising:

a. timing a user session, commencing upon the user interacting with a user interface (col 32, lines 8-52);

b. determining an elapsed time during the user session (col 32, lines 8-52); and

c. delivering the advertising content based on a selected interval of the elapsed time (col 32, lines 8-52).

Claims 2 and 3: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses commencing the timing upon an initial interaction by the user, such as selecting content through the interface (col 25, lines 61-67).

Claims 4 and 6: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses the interval being fixed or variable (col 32, lines 8-52).

Claim 8: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above and further discloses varying the time interval according to the content selected by the user using the AdController (col 32, line 53 – col 33, line 17).

Claims 9 and 10: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses pausing the timing step during the delivery of the advertising content and un-pausing the timing step after the delivery is completed (col 32, lines 8-52).

Claim 11: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses the delivery medium being at least one of the Internet, cable, digital subscriber line, and wireless (col 15, lines 48-64).

Claims 12 and 43: Landsman discloses a method for delivering advertising content to a user as in Claims 1 and 42 above, and further discloses the advertising content is streaming video (col 7, lines 29-42 and col 8, lines 1-4).

Claim 16: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses repeating the timing, determining, and delivering steps (col 32, lines 8-52).

Claim 18: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses the advertising content includes a link to at least one Internet address (col 2, lines 12-30 and col 3, lines 24-44).

Claim 19: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses the user interacting via a keyboard (Figure 3, item 395).

Claim 21: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, and further discloses the user interacting via a link to another web page (col 32, lines 8-52).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 5, 7, 13-15, 22-36, 38-41, and 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (6,314,451) in view of Capek et al (6,094,677).

Claim 5: Landsman discloses a method for delivering advertising content to a user as in Claim 4 above, but does not explicitly disclose that the fixed time interval is 5 minutes. The Examiner notes that the Applicant has not disclosed, nor discussed, any reason for or advantage in setting the length to exactly 5 minutes instead of 4 minutes or 30 seconds, or any other time; thus, the selection of 5 minutes is seen as a design decision which is given little, if any, patentable weight. It would have been obvious to

one having ordinary skill in the art at the time the invention was made to allow the designer to set the interval to 5 minutes or any other desired elapsed time interval. One would have been motivated to set the interval to a specific time, such as 5 minutes, in view of Landsman's disclosure of displaying the advertising content to the user "at regular time intervals" (col 32, lines 33-34).

Claims 7 and 25: Landsman discloses a method for delivering advertising content to a user, comprising:

a. timing a user session, commencing upon the user interacting with a user interface (col 32, lines 8-52);

b. determining an elapsed time during the user session (col 32, lines 8-52); and

c. delivering the advertising content based on a selected interval of the elapsed time (col 32, lines 8-52).

While Landsman does not explicitly disclose that the elapsed time is the amount of time between interactions with the user interface, it is disclosed that a variety of time measurements are being taken to include the length of the user session, the length of interstitial periods, etc. Selecting which time measurement to use to trigger the displaying of the advertising content would be a design decision of the entity setting up the system and would not affect the rest of the claimed steps of displaying the advertising content based on the elapsed time. The Examiner notes that this limitation also reads on displaying the advertising content after a period of inactivity by the user,

i.e. similar to a screen saver, which are well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to deliver the advertising content based on the amount of elapsed time between interactions of the user with the user interface. One would have been motivated to use this interval (or any other desired interval) in view of Landsman's disclosure of tracking various time measurements of the user's session.

Claim 31: Landsman discloses a method for delivering advertising content to a user as in Claim 25 above and further discloses the advertising content is streaming video (col 7, lines 29-42 and col 8, lines 1-4).

Claims 13, 32, and 44: Landsman discloses a method for delivering advertising content to a user as in Claims 12, 31, and 43 above, but does not disclose that the streaming video is broadcast quality video. The Examiner notes that the quality of the video does not affect the step of delivering the video advertising content to the user. Furthermore, Capek discloses a similar method for delivering streaming video advertising content to a user in which the streaming video is broadcast quality video (col 12, lines 64 – col 13, line 6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to deliver broadcast quality video advertising content to the user in Landsman. One would have been motivated to deliver broadcast quality video in order to present the user with the clearest and most legible advertising copy as possible.

Claims 14, 33, and 45: Landsman and Capek disclose a method for delivering streaming video advertising content to a user as in Claims 12, 31, and 43 above, but do not explicitly disclose that the video is delivered at a bit rate of at least 144 Kbps. The Examiner first notes that the speed of delivery through the Internet is based on the slowest connection during the transmission and that this connection is dynamic in that the connecting nodes are constantly changing. Thus, while it may be desired that the delivery rate does not fall below 144 Kbps, it cannot be assured when connecting through the Internet. Additionally, Official Notice is taken that it is old and well known to transmit streaming video at as high of bit rate as possible to prevent the video presentation from jerking or freezing. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to deliver the streaming video at 144 Kbps or faster, whenever possible. One would have been motivated to maintain this transmission speed in order to prevent jerking or freezing of the video presentation as discussed by Landsman (col 7, lines 29-48).

Claims 22 and 39: Landsman and Capek disclose a method for delivering advertising content to a user as in Claims 1 and 25 above, but do not explicitly disclose that the advertising content is delivered after the second interaction by the user. However, the Examiner notes that this is a design decision and that the frequency of presentation of the advertising content may be set at any desired level by the entity setting up the system, such as after every interaction, every other interaction, every

third interaction, etc. without affecting the other steps of the claims. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to set the frequency in Landsman to every two interactions. One would have been motivated to set the frequency at every two interactions to prevent overloading the user with advertising content.

Claims 23, 24, 40, 41, 47, and 48: Landsman and Capek disclose a method for delivering advertising content to a user as in Claims 1, 25, and 43 above. Landsman further disclosing delivering video content to the user (col 7, lines 29-42 and col 8, lines 1-4) and for delivering (displaying) the advertising content to the user after completion of the video content in order to create a commercial-free video (col 22, line 60 – col 23, line 4). Landsman discloses that the advertisement will not interrupt the content page being displayed to the user, but will only be displayed during the "breaks", i.e. when the user has requested another content page and that content page is still being downloaded.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (6,314,451) in view of Slotznick (6,011,537).

Claim 17: Landsman discloses a method for delivering advertising content to a user as in Claim 1 above, but does not explicitly disclose that the advertising content completely fills the visual display. However, Slotznick discloses a similar method for delivering advertising content to a user in which the advertising content fills the entire

display screen (visual display)(col 23, lines 11-16 and col 24, lines 23-28). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cover the entire visual display of Landsman's user with the advertising content. One would have been motivated to cover the entire visual display in view of Landsman's disclosure that the advertising content will be display prior to displaying the requested content. Having the advertising content cover the entire visual would eliminate any "dead" or "blacked-out" areas of the display while waiting for the requested content to be displayed.

11. Claims 20 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (6,314,451) in view of Capek et al (6,094,677) as applied to claims 1 and 25 above, and further in view of Slotznick (6,011,537).

Claim 20 and 37: Landsman and Capek disclose a method for delivering advertising content to a user as in Claims 1 and 25 above, but do not explicitly disclose the user interacting with the user interface via a voice-activated device. However, Slotznick discloses a similar method for delivering advertising content to a user in which the user may interact with the user interface by "speaking a command to a device equipped with a voice recognition module" (col 13, lines 21-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a voice-activated interfacing device in Landsman. One would have been motivated to use a voice-actuated device in order to allow the system to be used by

physically disabled users and by users who need a hands-free means for entering data, such as users who are driving vehicles.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Cohn et al (6,317,780) discloses a method for delivering advertising content to a user during idle times in the user's browsing device, wherein the advertising content is downloaded during the first idle time and is presented during the second idle time.

b. Scott et al(6,338,094) discloses a method for delivering video advertising content to a user in response to the user's selection of a video file for downloading (requesting a web address).

c. Klug et al (6,615,251) discloses a method for delivering advertising content to a user during the wait time of an Internet session.

d. Cannon et al (US2002/0016736) discloses a method for delivering advertising content to a user during breaks between requested webpages.

e. Borger et al (US2002/0062393) discloses a method for delivering advertising content to a user within web content in which the two contents are translated into audio for delivery to the user through a telephone or audio connection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703)

308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
September 1, 2004

James W. Myhre
Primary Examiner
Art Unit 3622